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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,039	08/27/2003	James J. Kernz	16514	5136

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EXAMINER

LEVINE, ADAM L

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/649,039

Applicant(s)

KERNZ, JAMES J.

Examiner

Adam Levine

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 59-78 is/are pending in the application.
- 4a) Of the above claim(s) 10, 11, 67 and 68 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 59-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8 August 2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant filed a response dated June 19, 2006, in reply to the requirement for restriction/election mailed May 9, 2006. Applicant has elected the invention of claims 1-16. Claims 17-58 have been cancelled. Claims 59-78 have been newly filed. Claims 10, 11, 67, and 68 are nonelected species claims that are deemed withdrawn and will not be examined in this office action. The claim listing inaccurately refers to these claims as (Original) and (New). The claims should correctly be listed as (Withdrawn). Claims 1-16 and 59-78 are pending.

Election/Restrictions

Applicant's election without traverse of claims 1-16 in the reply filed on June 19, 2006, is acknowledged. Claims 10 and 11 and newly filed claims 67 and 68 should be withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on June 19, 2006.

Drawings

The drawings are objected to for the reasons indicated in the attached "Notice of Draftsperson's Patent Drawing Review," PTO-948. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if

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only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is

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requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. **Claims 6 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The claims describe “connecting the database to a host computer, connecting a remote terminal to the host computer, sending a selected one of the unique identifying indicia from the remote terminal to the host computer and retrieving from the database at the remote terminal the relevant textual trade data for the one of the objects associated with the selected one of the unique identifying indicia.” This description is indefinite because it is internally inconsistent. It describes a database and remote terminal that communicate with each other through a host computer, but later in the same claims it locates the database at the remote terminal.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-16 and 59-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paskowitz (US Patent No. 6,377,937) in view of Mayer (US Patent No. 5,042,650).

Paskowitz teaches a method and system for grading and commoditizing objects, making them trade ready. Paskowitz teaches grading an object based upon a predetermined grading scale and generating a grade indicator for the object (see at least abstract, figs.1-6, column 3 lines 20-30, column 6 lines 32-58). Paskowitz teaches commoditizing the object by generating relevant textual trade data for the object and storing the relevant textual trade data in a database in a form for use in generating a trade listing for the object (see at least abstract, figs.3,5; column 1 lines 16-34, column 6 lines 32-58, column 8 lines 32-47, line 65 - column 9 line 9). Paskowitz teaches these steps for a plurality of objects and providing access to the relevant textual trade data in the database to sellers to generate trade listings for the objects (see at least abstract, column 6 lines 32-58). Paskowitz further teaches:

- providing access to the trade listings to the sellers and to buyers: within an online peer-to-peer trading environment (see at least figs.1,6; column 1 lines 8-14, column 2 lines 50-64).
- assigning a unique identifying indicia to each of the objects: connecting the database to a host computer, connecting a remote terminal to the host computer, sending a selected one of the unique identifying indicia from the remote terminal to the host computer and retrieving from the database at the remote terminal the

relevant textual or image trade data for the one of the objects associated with the selected one of the unique identifying indicia, providing relevant trade data to at least one online trade enabling facility (see at least fig.2, column 1 lines 8-14, column 3 lines 20-30, 50-59 (retrieving and displaying product information through the internet inherently involves a remote computer retrieving information from a database through a host computer), column 9 lines 48-60. Please note: this is interpreted as a remote terminal retrieving data from a database connected to the remote terminal by the host computer rather than a "database at the remote terminal." See above rejection under USC 112. The image or text data is descriptive material and is not functionally involved in the recited steps of the method. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381 , 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106). The provision of the data described can occur either in advance or contemporaneous with the trade listing); each of the unique identifying indicia is an assigned unique certificate number having a predetermined format (Please note: the format of the identifying indicia is descriptive material and is not functionally involved in the recited steps of the method. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381 , 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106).).

- the objects are at least one of coins, stamps, trading cards, currency and documents: the stored relevant textual trade data is at least one of a plurality of item specific attributes including a certificate number, a year of mintage indicator, a Mint branch indicator, a denomination indicator, type designation, grade indicator, and grading firm identifier (Please note: in the context of this invention, the nature of the objects only affects the information presented within the descriptive material. It has no actual role in the method. The description of the object is therefore descriptive material and is not functionally involved in the recited steps of the method. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381 , 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106).
- generating trade listings: from the stored relevant textual trade data in at least one trade enabling marketplace computer and providing access to the trade listings to the sellers and to buyers of the objects through computers connected to the marketplace computer (see at least abstract, figs.1,3,5,6; column 1 lines 8-34, column 2 lines 50-64, column 6 lines 32-58, column 8 lines 32-47, line 65 - column 9 line 9).

Paskowitz teaches all of the above as noted and teaches a) associating the grade indicator with the object, b) assigning a unique identifying indicia to each of the objects, and c) a method of trading in valuable objects that communicates data concerning the objects between buyers and sellers. Paskowitz however does not

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disclose encapsulating objects, associating the grade indicator with the object in a substantially permanent manner by encapsulating the object and a visual representation of the grade indicator in a tamper-evident holder and associating the assigned unique identifying indicia with the corresponding one of the objects encapsulated in the holder in a substantially permanent manner, printing the assigned associated unique identifying indicia onto a label and securing the printed label within the tamper-evident holder. Mayer teaches a) associating the grade indicator with the object, b) assigning a unique identifying indicia to each of the objects, and c) a method of trading in valuable objects that communicates data concerning the objects between buyers and sellers. Mayer also teaches encapsulating objects, associating the grade indicator with the object in a substantially permanent manner by encapsulating the object and a visual representation of the grade indicator in a tamper-evident holder, assigning a unique identifying indicia to each of the objects and associating the assigned unique identifying indicia with the corresponding one of the objects encapsulated in the holder in a substantially permanent manner, printing the assigned associated unique identifying indicia onto a label and securing the printed label within the tamper-evident holder, indicia being visibly conspicuous thereby indicating that the objects are trade ready (see at least abstract, figs.1-5). Mayer further teaches:

- providing a substantially planar upper enclosure element for receiving at least partially a coin retaining insert: (see at least abstract, figs.1-5).
- providing a substantially planar lower enclosure for receiving at least partially a coin retaining insert: (see at least abstract, figs.1-5).

- providing a coin retaining insert adapted for close fitting between the upper and the lower enclosure element: the coin retaining insert having an appropriately dimensioned aperture for confining the coin: (see at least abstract, figs. 1-5).
- mounting the coin within the aperture of the coin retaining insert: (see at least abstract, figs. 1-5).
- confining the insert including the coin between the upper and lower enclosure elements: (see at least abstract, figs. 1-5).
- sealing the enclosure elements using sonic welding means: (see at least abstract, column 3 lines 51-68).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method and system of Paskowitz to include encapsulating objects, associating the grade indicator with the object in a substantially permanent manner by encapsulating the object and a visual representation of the grade indicator in a tamper-evident holder, assigning a unique identifying indicia to each of the objects and associating the assigned unique identifying indicia with the corresponding one of the objects encapsulated in the holder in a substantially permanent manner, printing the assigned associated unique identifying indicia onto a label and securing the printed label within the tamper-evident holder, the indicia being visibly conspicuous, as taught by Mayer, in order to verify the authenticity and value of the object being sold or traded, increasing confidence in the objects traded through the method and system and correspondingly increasing the use of the method and system in commerce.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Levine whose telephone number is 571.272.8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Adam Levine
Patent Examiner
September 7, 2006



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